

REMARKS-General

1. The newly drafted independent claims 11 and 15 incorporate all structural limitations of the original claims 1 and 7, and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 11 to 21 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 1, 7-8, and 10 under 35USC102

2. The Examiner rejected claim 1 as being anticipated by Hirayama et al. (US 4,547,705) and claims 7-8 and 10 as being anticipated by Godyak et al. (US 5,834,905).

3. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the *invention* was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

4. In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her *invention was patent* in this country more than one year prior to the date of the application for patent in the United States.

5. However, the Hirayama and Godyak patents and the instant invention are not the same invention according to the fact that the independent claim of the Hirayama or Godyak patent does not read upon the instant invention and the independent claims 11 and 15 of the instant invention does not read upon the Hirayama or Godyak patent too. Apparently, the instant invention, which discloses a magnetic light with magnetic energy generator, should not be the same invention as the Hirayama and Godyak patents.

6. Apparently, Hirayama and Godyak fail to teach and anticipate the distinctive features of the instant invention as follows:

(a) In claims 11 and 15, "an assembled magnetic body comprising first and second of magnetic bodies" is claimed, wherein the first of magnetic body has a trough-shaped structure and the second of magnetic body is coupled with the first of magnetic body.

Accordingly, Hirayama merely teaches a discharge lamp lightening device which comprises a core structure, wherein the core structure comprises a center core 2 sandwiched between two side cores 1. It is clearly that Hirayama fails to anticipate any trough-shaped magnetic core being covered by another magnetic core.

On the other hand, Godyak merely teaches an electric lamp assembly which comprises two transformer cores 22 and 24. However, Godyak fails to anticipate any trough-shaped magnetic core being covered by another magnetic core.

(b) In claims 11 and 15, "the second of magnetic member covers with the trough of the first of magnetic member" is claimed to enclose the projected pin of the first of magnetic member and the elongated inserter of the second of magnetic member within the trough of the first of magnetic member.

Hirayama merely teaches each of the side cores 1 has an E-shaped cross section and the center core 2 has either I-shaped cross section or T-shaped cross section.

Godyak is silent regarding any trough configuration of the transformer core 22 and 24.

(c) In claims 11 and 15, "the elongated inserter of the second of magnetic member is aligned with the projected pin of the first magnetic member" when the first and second of magnetic members are coupled with each other.

Hirayama merely teaches the center core 2 being coupled between two E-shaped side cores 1. As shown in Figures of Hirayama, the legs A, B of the side cores 1 are aligned with each other. However, the side cores 1 are separated by the center core 2 that the legs A, B of the side cores 1 are divided by the center core 2.

Godyak is silent regarding any alignment configuration of the transformer core 22 and 24.

(d) In claims 11 and 15, "a fixed magnetic air gap is formed" between the elongated inserter of the second of magnetic member and the projected pin of the first magnetic member. Clearly, the magnetic air gap is a space formed between the free ends of the elongated inserter and the projected pin.

Hirayama merely teaches a narrow gap spaces 5 are provided between the center core 2 and the inner legs B. It is clear that Hirayama fails to anticipate the structure of the instant invention of forming the fixed magnetic air gap between the elongated inserter and the projected pin which is aligned with the elongated inserter. In addition, the magnetic air gap is a space between the free ends of the elongated inserter and the projected pin. However, the free ends of the inner legs B of Hirayama are separated by the center core 2. Therefore, the space configuration of the magnetic air gap of the instant invention is totally different from that of the narrow gap spaces 5 taught by Hirayama.

Godyak is silent regarding any fixed magnetic air gap of the transformer core 22 and 24.

(e) In claims 11 and 15, "an insulated bakelite frame" extended from the projected pin to the elongated inserter is claimed, wherein both Hirayama and Godyak are silent regarding any insulated bakelite frame.

(f) In claims 11 and 15, "an electromagnetic induction coil enwinding with the insulated bakelite frame from the projected pin to the elongated inserter through the magnetic air gap" is claimed. It is clearly that the insulated bakelite frame and the electromagnetic induction coil are provided at the projected pin and the elongated inserter. In addition, the insulated bakelite frame of the instant invention is also provided at the magnetic air gap in page 5, lines 10-11 in the specification and is shown in the Figures of the instant invention.

Hirayama merely teaches the primary winding 3 provided between the inner legs B and B' and the secondary winding 4 provided between the outer leg A and the inner leg B. It is clearly that Hirayama fails to anticipate the winding extended from the inner leg of one of the side cores 1 to the inner leg of another side core 1'. It is worth mentioning that the magnetic air gap of the instant invention is a space between the free ends of the elongated inserter and the projected pin. Therefore, the insulated bakelite frame and the electromagnetic induction coil can extend from the elongated inserter to the projected pin through the magnetic air gap.

Godyak is silent regarding any winding coil extending through any magnetic air gap.

It is worth mentioning that the magnetic energy generator of the instant invention is coupled at the through slot of the light body that the first of magnetic member is wrapped at the through slot while the second of magnetic member is coupled with the first of magnetic member. Such attachment of the magnetic energy generator has a relative simpler structure, and several distinctive features, such as easier installation, simple manufacturing procedure, low costs, and more importantly, a relative securer and fixed magnetic air gap between the elongated inserter and the projected pin, as mentioned in page 5, lines 21-24.

In addition, the magnetic body is arranged to contact with the light body for enhancing the electromagnetic efficiency, in page 5, lines 28-29.

The magnetic radiation will be significantly reduced and the electromagnetic efficiency will be improved. In short, the magnetic energy generator enables the electromagnetic induction current and resonance frequency controllable and manageable in practices, in page 6, lines 7-10.

7. Accordingly, Hirayama and Godyak fail to teach and anticipate the distinctive features (a) to (f) of the instant invention. Hirayama and Godyak are not a qualified prior art of the instant invention and should be removed from the prior art list of the instant invention.

Response to Rejection of Claims 2-6 and 9 under 35USC103

8. The Examiner rejected claims 3-6 over Hirayama in view of Thompson (US 5,395,218), claim 2 over Hirayama in view of Thompson and further in view of Kawaguchi et al (US 4,163,826), and claim 9 over Godyak in view of Hirayama. Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically disclosed or described as set forth in section 102 of this title**, if the **differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains**. Patentability shall not be negated by the manner in which the invention was made."

9. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

10. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Hirayama and/or Godyak which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Thompson and/or Kawaguchi at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

11. As recited above, both Hirayama and Godyak fail anticipate above distinctive features (a) to (f). In addition, regarding to claims 12-14 and 16-21, the instant invention further contains the following distinctive features:

(g) Both Hirayama and Godyak do not teach the engaging shoulder of the first of magnetic member is coupled with the engaging shoulder of the second of magnetic member, as claimed in claims 12 and 16 in addition to what is claimed in claims 11 and 15 as a whole. Accordingly, the engaging shoulders of the first and second of magnetic members not only allow the first and second magnetic members detachably coupling with each other but also ensure the projected pin and the elongated inserter being aligned with each other.

Accordingly, the magnetic members have engaging shoulders respectively defined at two side ends for intensifying the relative positioning and attaching status, and more importantly, the fixed magnetic air gap will guarantee the electromagnetic induction current well calculated and measured in applications, as mentioned in page 6, lines 10-13.

(h) Both Hirayama and Godyak fail to teach the configuration of the electromagnetic induction coil enwinding with the insulated bakelite frame, as claimed in claims 13-14 and 17-18 in addition to what is claimed in claims 11 and 15 as a whole. Accordingly, the configuration of the instant invention is selected from a group

consisting of a single multi-enamel wire wrapped by an insulated casing, two or four of parallel entwisted multi-enamel wires wrapped with an insulated casing, a plurality of wires wrapped within an insulated casing with varied diameter or varied quantity, and a plurality of copper wires wrapped by the insulated casing, wherein a winding circle of said electromagnetic induction coil is a complete circle or as many as N circles.

(i) Godyak fails to teach the light, having an inner cavity, a through slot, a fluorescent layer, an inert air and mercury, incorporating with the magnetic energy generator having a fixed magnetic air gap therein, as claimed in claims 19-21 in addition to what is claimed in claim 15 as a whole.

12. Whether the claims 12-14 and 16-21 as amended of the instant invention are obvious depends on whether the above differences (a) to (i) between the instant invention and Hirayama/Godyak are obvious in view of Thompson and/or Kawaguchi at the time of the invention was made.

13. Furthermore, the applicant respectfully submits that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

14. Also, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

15. Thompson merely suggests that each of the windings 52, 54, 56, 58, is a common wound magnetic coil provided around a plastic sleeve 60 wherein each winding includes side plates 62 formed of bakelite or plastic for electrically insulating the winding

from adjacent windings or other structure. However, Thompson does not suggest any winding and/or side plates extended from the projected pin to the elongated inserter through the magnetic air gap. In addition, the winding of Thompson cannot be applied to the structure of Hirayama. More specifically, the winding of Thompson cannot couple between the inner leg B of the side core 1 to the center core 2 taught by Hirayama because the inner leg B of the side core 1 is NOT aligned with the center core 2. And, the winding of Thompson cannot couple between the inner legs B of the side cores 1 because the inner legs B of the side cores 1 are blocked by the center core 2.

16. Kawaguchi merely suggests a self-bonding magnet wire suitable for use in making coils. However, the coil structure of the instant invention is not the same of the coil structure of Hirayama combined with the winding structure of Thompson. Therefore, even though applying the magnet wire of Kawaguchi to the winding structure of Thompson, Hirayama with Thompson and Kawaguchi fail to teach the distinctive feature of the instant invention of the insulated bakelite frame and the electromagnetic induction coil extending from the elongated inserter to the projected pin through the magnetic air gap.

17. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..." *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

18. Accordingly, the applicant believes that neither Hirayama, Godyak, Thompson, nor Kawaguchi, separately or in combination, suggest or make any mention whatsoever of the difference subject features (a) to (i) as claimed in the amended claims 11 to 21 of the instant invention.

19. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

20. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

21. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 11 to 21 at an early date is solicited.

22. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

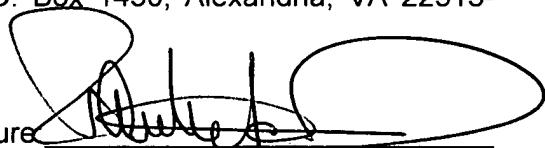


Raymond Y. Chan
Reg. Nr.: 37,484
108 N. Ynez Ave.
Suite 128
Monterey Park, CA 91754
Tel.: 1-626-571-9812
Fax.: 1-626-571-9813

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Person Signing: Raymond Y. Chan